IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Docket No.: 702.124
CHILDS, MICHAEL, ET AL.	
Application No.: 10/086,370	Group Art Unit No.: 3663
Filed: February 28, 2002	
SYSTEMS, FUNCTIONAL DATA, AND METHODS TO PACK N-DIMENSIONAL DATA	Examiner: MANCHO, RONNIE M.

REPLY BRIEF

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APPELLANTS' REPLY BRIEF

In response to the Examiner's Answer dated August 6, 2009, Appellants' Reply Brief in accordance with 37 C.F.R. § 41.41 is hereby submitted. The Examiner's final rejections of claims 1-3, 6-12, and 25-32 are herein appealed, and allowance of said claims is respectfully requested.

Should any fee be due, the Commissioner is hereby authorized to charge the amount of the filing fee for this Reply Brief, or any additional fees which may be required, or credit any overpayment, to Account No. 501-791.

Respectfully submitted,

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I. Status of Claims

Claims 1-3, 6-12, and 25-32 are pending, rejected, and herein appealed, with claims 1, 9, and 25 being independent and claims 4-5 and 13-24 being previously canceled.

II. Grounds of Rejection to be Reviewed on Appeal

A. Whether claims 25-32 were properly rejected under 35 U.S.C. § 112, ¶ 1, for failing to comply with the written description requirement.

B. Whether claims 25-32 were properly rejected under 35 U.S.C. § 112, ¶ 1, for failing to comply with the enablement requirement.

C. Whether claims 1, 2, 6, 7, 8, and 25-32 were properly rejected under 35 U.S.C. § 102(e) for being anticipated by Friederich (U.S. Patent No. 6,600,841).

D. Whether claim 3 was properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Friederich and Robinson (U.S. Patent No. 5,995,970).

E. Whether claims 9-12 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Friederich in view of Ito (U.S. Patent No. 6,484,093).

III. Argument

A. Whether claims 25-32 were properly rejected under 35 U.S.C. § 112, ¶ 1, for failing to comply with the written description requirement.

Appellants note that the Examiner apparently withdrew this rejection on page 15 of the Answer.

B. Whether claims 25-32 were properly rejected under 35 U.S.C. § 112, ¶ 1, for failing to comply with the enablement requirement.

Appellants note that the Examiner modified the basis for this rejection from the rejection presented in the September 17, 2008, final Office Action. Specifically, the rejection within ¶ 4 of the final Office Action identified the "the processor maps the specific values with portions of the compressed navigation data using the activation data and dynamically decompresses those mapped portions and communicates the decompressed mapped portions to the display" limitation of claim 25 as failing the enablement requirement. In the Examiner's Answer, the Examiner now identifies—for the first time on this third appeal after 7 years of prosecution[1]—that it is actually the "a Global Positioning Satellite (GPS) receiver that cooperates with the processor and provides to the processor specific values for coordinate data" limitation of claim 25 that fails the enablement requirement.

Appellants respectfully submit that this functionality is fully enabled by the specification. Unpacking and packing coordinate data stored on a GPS device based on the location of the GPS device is discussed within the "Background of the Invention" section on page 1 of the specification ("Cartographic data is voluminous and as a result, often only specific cartographic data associated with predefined geographic regions is loaded into the device during any particular operation cycle....[a]ccordingly, cartographic data is packed or compressed to achieve more efficient usage of limited memory

[1] "In accordance with the principles of compact prosecution, if an enablement rejection is appropriate, the first Office action on the merits should present the best case with all the relevant reasons, issues, and evidence so that all such rejections can be withdrawn if applicant provides appropriate convincing arguments and/or evidence in rebuttal." *MPEP § 2164.04.*

resources.") Appellants do not assert that compressing/decompressing coordinate data based on device location alone is novel as of the priority date of the present application.

Further, at least the portions of the specification discussed on pages 10-13 of Appellants' Brief enable this functionality. As one example, the reproduced portions of pgs. 17-18 of the specification include a discussion on how "the activation data 650 assists in only packing or unpacking dimensions 660 being used by the device 600" – which is based on location information provided by the GPS receiver (e.g., in the embodiment of FIG. 9 discussed on pages 20-21 "functional data 810 can be configured to dynamically receive a present location data associated with the navigation device 800...[t]he functional data 810 can be used to efficiently unpack the compressed/packed data 870 as well.")

Regardless, the Examiner's arbitrary and ever-changing enablement rejections do not require Appellants to produce an infinite set of explanations as to why the claimed subject matter is enabled or otherwise found in the specification. Indeed, a *prima facie* case of non-enablement is only satisfied when the Examiner has a "reasonable basis" to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993), see also *MPEP § 2164.05* ("***Once*** the examiner has weighed all the evidence and established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on applicant...") (emphasis added). An enablement rejection must be reached by weighing all of the *Wands* factors and concluding that undue experimentation would be required to practice the claimed invention. *MPEP § 2164.01a.*

Here, the Examiner's Answer does not even mention the phrase "undue experimentation" let alone discuss any of the *Wands* factors or provide any other reasoned analysis. Instead, the Examiner's Answer asks where various limitations are shown in the specification, suggesting perhaps that the Examiner intended to withdraw the enablement rejection and not the written description rejection. Appellants submit, as discussed above, that one skilled in the art would be able to practice the claimed invention without undue experimentation based at least on the portions of the specification discussed above and in Appellants' Appeal Brief.

C. Whether claims 1, 2, 6, 7, 8, and 25-32 were properly rejected under 35 U.S.C. § 102(e) for being anticipated by Friederich (U.S. Patent No. 6,600,841)

Appellants' arguments found in its Appeal Brief are fully responsive to the anticipation and obviousness positions outlined in the Examiner's Answer and are not repeated herein.

D. Whether claim 3 was properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Friederich and Robinson (U.S. Patent No. 5,995,970).

Claim 3 depends from independent claim 1, which is discussed above at length in Appellants' Appeal Brief. Appellants respectfully submit that claim 3 is allowable for the same reasons discussed above regarding independent claim 1.

E. Whether claims 9-12 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Friederich in view of Ito (U.S. Patent No. 6,484,093).

Independent claim 9 recites using compression and decompression instructions as discussed in Appellants' Appeal Brief regarding independent claim 1. As such, Friederich does not anticipate claim 9 or the claims that depend therefrom.

VIII. Conclusion

The Examiner's § 112 rejections are without merit as all claimed features of the present invention are fully enabled, supported by the specification, and clear in scope to those skilled in the art. Further, the Examiner has failed to establish a *prima facie* case of anticipation or obviousness as the Examiner's combination does not disclose or suggest compression using activation data.

Accordingly, reversal of the Examiner's rejections is proper, and such favorable action is solicited.

Respectfully submitted,

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